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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,337	01/30/2004	Mark Ferraro	770P011329-US (PAR)	6516

7590 12/02/2005
Perman and Green, LLP
425 Post Rd.
Fairfield, CT 06824

EXAMINER

CANGIALOSI, SALVATORE A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/768,337	Applicant(s) FERRARO, MARK	
	Examiner Salvatore Cangialosi	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/3/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/3/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112: The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed contains no support for "locally modifiable (claim 1) or locally modifying (claim 11)" or any word having the root local or modif. There are new claims without support in the specification. This is the first instance of this invention that is unrelated and unsupported by the original filing. Cancellation of the new matter is required.

Applicants arguments dated 9/2/05 have been considered but are deemed without merit since the applicant argues an invention lacking support in the specification and based entirely on new matter.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second

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paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Certain claims (1, 2, 4, 11, 13) contain the terms "being readable...locally modifiable...configurable...to be dispensed...to be imprinted... being readable... to be dispensed" which are not positive limitations. (See In re Collier, 158 USPQ 266) It is not clear what is being claimed. The claims require only a possibility rather than an actual limitation. For example, anything is possible given sufficient time and resources.

3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4. Claims 1-13 are rejected under 35 U.S.C. § 103 as being unpatentable over Wright et al (4802218).

Regarding claim 1, Wright et al (See abstract,

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Figs. 7, 10, and 12, Col. 3, lines 35-65, Cols. 7-14, claims 1-42) disclose a postage meter means for printing authenticated postage by means of remote instruction means(cards) that are locally modifiable substantially as claimed. The differences between the above and the claimed invention is the use of specific phraseology. It is noted that it is believed that the claims cards are functionally equivalent to the claimed limitations of both remote location and locally modifiable. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Wright et al because the smart card are conventional functional equivalents with respect to the claim limitations and their employment and comparison is a necessary component of authentication and use in a postal transaction and because local and remote are relative terms. Regarding the device limitations of claims 2-10, Wright et al (See abstract, Figs. 7, 10, and 12, Col. 3, lines 35-65, Cols. 7-14, claims 1-42) disclose a postage meter means for printing authenticated postage by means of remote instruction means(cards) that is a functional equivalent of the claim limitations(See also office action dated 5/31/05). Regarding claim 11, Wright et al (See abstract, Figs. 7, 10, and 12, Col. 3, lines 35-65, Cols. 7-14, claims 1-42) disclose a postage meter method for printing authenticated postage by means of remote instruction means(cards) that are locally modifiable substantially as claimed. The differences between the above and the claimed invention is the

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use of specific phraseology. It is noted that it is believed that the claims cards are functionally equivalent to the claimed limitations of both remote location and locally modifiable. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Wright et al because the smart card are conventional functional equivalents with respect to the claim limitations and their employment and comparison is a necessary component of authentication and use in a postal transaction and because local and remote are relative terms. Regarding the method limitations of claims 12 and 13, Wright et al (See abstract, Figs. 7, 10, and 12, Col. 3, lines 35-65, Cols. 7-14, claims 1-42) disclose a postage meter method for printing authenticated postage by means of remote instruction means (cards) that is a functional equivalent of the claim limitations (See also office action dated 5/31/05).

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number **(571) 272-6927**. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at **(571) 272-6712**.

Any response to this action should be mailed to:

Mail Stop Amendment
Commissioner for Patents

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or faxed to (571)273-8300

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SALVATORE CANGIALOSI
PRIMARY EXAMINER
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